Supreme Court, U.S.
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No. 95-1721

IN THE

# Supreme Court of the United States

October Term, 1995

**IMAZIO NURSERY, INC.,**

***Petitioner,***

**v.**

**COASTAL NURSERY, JESS RODRIGUES, and DONNA RODRIGUES,**

***Respondents.***

## RESPONDENTS' BRIEF IN OPPOSITION

PHILIP C. SWAIN
*Counsel of Record*
KIRKLAND & ELLIS
300 South Grand Avenue
Los Angeles, CA 90071
(213) 680-8400

JAY I. ALEXANDER
KIRKLAND & ELLIS
655 Fifteenth Street, N.W.
Washington, DC 20005
(202) 879-5000

*Counsel for Respondents*

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## REASONS FOR DENYING THE WRIT

The Court should deny *certiorari* in this case for three reasons:

*First*, this case does not warrant this Court's review because it has always been understood that the plant patent grant contained the limitations articulated by the Federal Circuit in the decision below. As shown by their relative rarity, plant patents have not historically been often obtained or litigated in the horticulture industry.

*Second*, Congress is currently considering amendments to the Plant Patent Act. The legislature, and not the Court, is the appropriate place to debate the policy issues raised in the petition.

*Third*, the Federal Circuit – the court created by Congress to bring consistency and coherence to patent law – correctly interpreted the plant patent statute. Because the Federal Circuit's jurisdiction over patent cases is exclusive, and its interpretation is consistent with the sparse but discernible precedent of other circuit courts, the decision below cannot and does not create a conflict among circuits.

### A. The petition does not raise an important question of law because the Plant Patent Act is rarely invoked.

In the 65 years since the Act became law, there have been only eight plant patent infringement cases (including this

one) that have resulted in reported decisions.[1] The decision below, issued in 1995, was the first appellate decision to directly decide the requirements for proof of plant patent infringement.

Since 1930, the United States Patent & Trademark Office ("PTO") has issued fewer than 10,000 plant patents. *See* United States Plant Patent No. 9,535 (issued April 30, 1996). A comparison with issued utility patents illustrates the relative obscurity of plant patents. In the same time period, the PTO issued over three and one half million utility patents. *Compare* United States Utilitv Patent No. 5,513,390 (issued April 30, 1996) and United States Utility Patent No.1,753,761 (issued April 8, 1930).

Plant patents are relatively rare because their scope is limited. This widespread understanding is revealed in the writings of commentators from the 1930s to the present, many of which are cited in the decision below. *See, e.g.,* Robert S. Allyn, *The First Plant Patents* at 28 (1934) ("The fact that the Commissioner of Patents has ruled that only a single claim will be permitted in these plant patents indicated that he regards the

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1 *See Imazio Nursery, Inc. v. Dania Greenhouses*, 29 U.S.P.Q.2d 1217 (N.D. Cal. 1992), *rev'd in part, vacated in part,* 69 F.3d 1560 (Fed. Cir. 1995); *Pan-American Plant Co. v. Matsui*, 433 F. Supp. 693 (N.D. Cal. 1977); *Yoder Bros., Inc. v. California-Florida Plant Corp.*, 537 F.2d 1347 (5th Cir. 1976), *cert. denied,* 429 U.S. 1094 (1977); *Nicholson v. Bailey*, 182 F. Supp. 509 (S.D. Fla. 1960); *Kim Bros. v. Hagler*, 167 F. Supp. 665 (S.D. Cal. 1958), *aff'd*, 276 F.2d 259 (9th Cir. 1960); *Armstrong Nurseries, Inc. v. Smith*, 170 F. Supp. 519 (E.D. Tex. 1958); *Bourne v. Jones*, 114 F. Supp. 413 (S.D. Fla. 1951), *aff'd,* 207 F.2d 173 (5th Cir.), *cert. denied,* 346 U.S. 897 (1953); *Cole Nursery Co. v. Youdath Perennial Gardens, Inc.*, 17 F. Supp. 159 (N.D. Ohio 1936), *dismissed,* 101 F.2d 1007 (6th Cir. 1939).

protection intended by the Statute as limited to the exact variety described."); Robert S. Allyn, *Plant Patents 1934-1943* at 12 (1944) ("[M]ost plant patents if sustained at all by the Courts will be considered as covering only plants which have been asexually reproduced from the original plant."); Peter F. Langrock, *Plant Patents--Biological Necessities in Infringement Suits*, 41 J. Pat. Off. Soc'y 787, 787 (1959) ("[T]he grant to a patentee of a plant patent is only the exclusive right to asexually reproduce the patented plant."); Edward A. Hayman, *Botanical Plant Patent Law*, 11 Clev. Marshall L. Rev. 430, 433 (1962) ("[A] plant patent only protects the clones, or in other words, the asexual progeny of a particular plant."); David B. Bernstein, *Is a Plant Patent a Form of Copyright?*, 27 IDEA 31, 35 (1986) ("The relevant court holdings have suggested that no infringement of a plant patent can occur without an actual, physical taking from the plant discovered by the patentee."); 1 Donald S. Chisum, *Patents*, § 1.05[1][d], at 271-272 (1993) ("It is generally assumed that one infringes only if the accused plant is a direct or indirect asexual reproduction of the patentee's original parent plant.")

The opinion below confirms the understanding that the scope of the plant patent is limited to the right to exclude others from asexually reproducing, using and selling the patented plant or its asexually produced progeny. In the nearly seven decades since the enactment of the Plant Patent Act, the horticultural industry of the United States has thrived on that understanding.

**B. The Petitioner's policy arguments are best left to Congress, which is considering a current proposal to amend the Plant Patent Act.**

To the extent the policy concerns over the present statute raised in the petition are valid, Congress, not this Court, is the proper forum in which to resolve them. *See United States v. Sotelo*, 436 U.S. 268, 279 (1978) ("However persuasive these considerations might be in a legislative forum, we as judges cannot override the specific policy judgments made by Congress in enacting the statutory provisions with which we are here concerned." ); *Victory Carriers, Inc. v. Law*, 404 U.S. 202, 216 (1971) ("Claims [that laws provide inadequate benefits] are best presented in the legislative forum, not here.")

A bill is currently pending before the Subcommittee on Courts and Intellectual Property of the House Judiciary Committee, that contains changes to the language of the Plant Patent Statute.[2] In its present form, the bill retains the statutory

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[2] H.R. 3460, 104th Cong., 2d Sess., as marked up by the subcommittee on May 15, 1996, contains the following language:

> **SEC. 603. PLANT PATENTS.**
>
> (a) TUBER PROPOGATED PLANTS.–Section 161 of title 35, United States Code, is amended by striking "a tuber propagated plant or".
>
> (b) RIGHTS IN PLANT PATENTS.–The text of section 163 of title 35, United States Code, is amended to read as follows: "In the case of a plant patent, the grant to

(continued...)

language requiring "asexual reproduction" for infringement of a plant patent. However, some parties have proposed other language that would eliminate the asexual reproduction requirement in accordance with the policy preferences expressed in the petition.[3]

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[2] (...continued)

the patentee, such patentee's heirs or assigns, shall have the right to exclude others from asexually reproducing the plant, and from using, offering for sale, or selling the plant so reproduced, or any of its parts, throughout the United States, or from importing the plant so reproduced, or any parts thereof, into the United States.".

(c) EFFECTIVE DATE.--The amendments [sic--made] by subsection (a) shall apply on the date of enactment of this Act. The amendments made by subsection (b) shall apply to any plant patent issued on or after the date of enactment of this Act.

[3] One example of such a proposal is a proposed resolution currently pending in a committee of the Intellectual Property Section of the American Bar Association. The ABA resolution provides:

Proposed Resolution 1002-1

RESOLVED, that the Section of Patent, Trademark and Copyright law favors in principle its support for broadening the scope of the Plant Patent Act; and

Specifically, the Section affirms a legislative proposal to (a) amend 35 U.S.C. Section 161 by striking out the phrase "a tuber propagated plant or" and (b) amend 35 U.S.C. Section 163 to read as follows:

"In case of a plant patent, the grant to the patentee, his heirs or assigns, shall be of the right to exclude others from reproducing the plant, and from using, offering for

(continued...)

It is thus likely that Congress will directly consider whether the scope of the plant patent should be broadened in the manner asserted by petitioner. It is beyond the province of this Court to make that policy choice.

### C. The Federal Circuit's interpretation of the Plant Patent Act is consistent with the interpretation of other circuits and Congress' intent.

The Court should also deny *certiorari* because the Federal Circuit's decision can not and does not conflict with the law of other circuits, and, in any event, is correct.

#### 1. The Federal Circuit's decision can not and does not conflict with the law of other circuits.

The Federal Circuit was created in 1982 to bring uniformity and coherence to the patent laws of the United States. *See* Federal Courts Improvement Act of 1982, Pub.L. 97-164, § 402, 96 Stat. 37 (1982); *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 820 (1988) (Stevens, J., concurring). The Plant Patent Act is within that court's exclusive jurisdiction. 28 U.S.C. § 1295(a)(1) (1994). By

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[3] (...continued)
selling the plant so reproduced, or any parts thereof, throughout the United States, or from importing the plant so reproduced, or any parts thereof, into the United States."

This proposal would delete the present requirement for asexual reproduction for infringement of a plant patent.

statutory definition, no conflict can arise between a decision of the Federal Circuit and another circuit court of appeal on an issue relating to patent law. Moreover, the Federal Circuit's interpretation of the scope of a plant patent is consistent with the discernible precedent of other pre-1982 circuit courts.

Although no other circuit court had directly ruled on the scope of the plant patent in the 65 years of the Plant Patent Act, other circuit courts had implied *in dicta* that asexual reproduction of the patented plant was required to prove infringement. In *Yoder Bros., Inc. v. California-Florida Plant Corp.*, 537 F.2d 1347, 1380 (5th Cir. 1976), *cert. denied*, 429 U.S. 1094 (1977), the Fifth Circuit affirmed a finding of infringement based on the defendants' admitted taking of cuttings of the patented plant. The court noted that asexual reproduction had been described as the "very essence" of the plant patent, and that asexual reproduction is "literally the only way that a breeder can be sure that he has reproduced a plant identical in every respect to the parent." *Id.* The court thus concluded that

> If the alleged infringer could somehow prove that he had developed the plant in question independently, then he would not be liable in damages or subject to an injunction for infringement. This example illustrates the extreme extent to which asexual reproduction is the heart of the present plant patent system: the whole key to the "invention" of a new plant is the discovery of new traits *plus* the foresight and appreciation to take the step of asexual reproduction.

*Id.* (footnote omitted; emphasis added).

The Court of Customs and Patent Appeals also took the view that plant patent "infringers must be shown to have asexually reproduced or sold or used the plant on which the patent was granted." *In re LeGrice*, 301 F.2d 929, 944 (C.C.P.A. 1962). The CCPA, although not dealing directly with the issue of infringement, made the quoted statement in explaining the congruence with the requirement that a printed publication must be enabling to constitute a statutory bar to a plant patent under 35 U.S.C. § 102(b) (1994).

### 2. The Federal Circuit's statutory interpretation is correct.

The Federal Circuit's adherence to the views of other circuits and commentators is consistent with the statutory language and Congress' intent in the passage of the Plant Patent Act. The statutory language and legislative history of the Plant Patent Act establish that Congress used the words "distinct and new variety of plant" in 35 U.S.C. § 161 (1994) simply to express the requirement that the patented plant be distinct from prior known plants.

Congress did not intend that plant patents be granted on plants that were not distinct from those already known. The legislative reports emphasized that "[t]he bill authorizes the grant of a patent only in case the new variety is distinct." S. Rep. No. 315, 71st Cong., 2d Sess. at 4, Pet. App. 80 (hereinafter "Senate Report"). Thus, the statute requires that a plant must be a "distinct and new variety" before a plant patent may issue. 35 U.S.C. § 161 (1994). Congress intended that the plant patent specification describe the characteristics of the plant that distinguished it from known varieties following the "practice among botanists in making use of

verbal descriptions and photographic and other reproductions, taking some known plant as a basis of comparison." Senate Report at 4-5, Pet. App. 81. The PTO examines the application for a plant patent for novelty over the prior art based on the description in the application. PTO Manual of Patent Examination Procedure, § 1608 (Rev. 14, Nov. 1992), Fed. Cir. Appendix 2479-2480.

The legislative history does not indicate that Congress used the term "variety" in its formal taxonomical sense in section 163. Rather, the context of the use of the term in the statute and in the House and Senate Reports shows that Congress used the term in the vernacular; that is, a variety is "something differing from others of the same general kind." *Websters Ninth New Collegiate Dictionary* (1989). For example, the Senate Report evidences Congress' understanding that, in the absence of asexual reproduction, there is never more than one specimen of a "new variety":

> Whether the new variety is a hybrid, mutant or sport, there is *never more than one specimen* of it produced except through asexual reproduction. For example, without asexual reproduction there would have been but *one* true McIntosh or Greening apple tree. These varieties of apple could not have been preserved had it not been through human effort in the asexual reproduction of the two original trees. They could not have been reproduced true to the type by nature through seedlings. The bill, therefore, proposes to afford through patent protection an incentive to asexually reproduce new varieties. Many varieties of

> apples equally as valuable as the McIntosh or Greening have undoubtedly been created and disappeared beyond human power of recovery because no attempt was made to asexually reproduce the new varieties. The present bill by its patent protection proposes to give the necessary incentive to preserve new varieties.

Senate Report at 4, Pet. App. 80 (emphasis added).

If petitioner were correct that Congress used the term "variety" in its taxonomical sense, these statements in the Senate Report could not be true. There is no evidence that the drafters of the Plant Patent Act or its legislative history were experts in botanical taxonomy or that they intended to use the term "variety" in its technical sense.

Moreover, the grant of the right to exclude contained in section 163 is directed to "the plant"; it is not directed to a "variety of plant." If petitioner were correct that the right to exclude covers a range of plants within a variety, Congress would also have used the term "variety" in section 163. Congress did not do so because it intended that the right to exclude should include only asexual reproduction, use and sale of the particular patented plant.

In the absence of contrary evidence of congressional intent, words in a statute are accorded their common, ordinary meaning. *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980); *Perrin v. United States*, 444 U.S. 37, 42 (1979). "The evident intent of Congress should not be obscured by deliberately over-refining the meaning of words where Congress has given no indication that it intended such meaning." *In re Bergy*,

596 F.2d 952, 980 n.15 (C.C.P.A. 1979), *aff'd sub nom. Diamond v. Chakrabarty*, 447 U.S. 303 (1980). Adoption of petitioner's statutory interpretation would contravene this precedent by reading into the term "variety" a technical meaning – not its ordinary meaning – where Congress did not clearly express its intent to use the technical meaning.

The reason Congress did not use the taxonomical definition of "variety" in the Plant Patent Act is apparent: in 1930, Congress did not believe that novel plants could be reproduced true-to-type by any means other than by asexual reproduction. *See Diamond v. Chakrabarty*, 447 U.S. at 313 ("[S]exually reproduced plants were not included under the 1930 Act because new varieties could not be reproduced true-to-type through seedlings. . . . By 1970, however, it was generally recognized that true-to-type reproduction was possible and that plant patent protection was therefore appropriate.") Thus, there was no reason for Congress in 1930 to have provided exclusive rights for asexual reproduction to a range of plants having a similar set of characteristics. It was not until passage of the Plant Variety Protection Act ("PVPA") in 1970 that Congress, in recognition of technological advances in plant breeding allowing true-to-type sexual reproduction, created protection for a range of plants that were part of a "novel variety" as that term is used in its botanical sense.

Congress did provide a technical taxonomical definition of "variety" in the PVPA. 7 U.S.C. § 2401 (1994). The fact that such a definition is absent from the Plant Patent Act is evidence that Congress did *not* intend that definition to apply. *See West Virginia Univ. Hosp., Inc. v. Casey*, 499 U.S. 83, 88-92 (1991) (where a term used in one statute is absent from a

second similar statute, the presumption is that Congress intended to omit the term in the second statute).

The Federal Circuit's interpretation of the plant patent infringement statute is correct. We submit that the arguments of the petitioner and the self-interested *amici curiae* that may file briefs, the Plant Patent Owners Association and the International Community of Breeders of Asexually Reproduced Ornamental and Fruit Tree Varieties, are without merit.

## CONCLUSION

For the foregoing reasons, the petition for writ of *certiorari* should be denied.

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Respectfully submitted,

PHILIP C. SWAIN
*Counsel of Record*
KIRKLAND & ELLIS
300 South Grand Avenue
Los Angeles, CA 90071
(213) 680-8400

JAY I. ALEXANDER
KIRKLAND & ELLIS
655 Fifteenth Street, N.W.
Washington, DC 20005
(202) 879-5000

*Counsel for Respondents*